

## REMARKS/ARGUMENTS

Applicants have studied the Office Action dated November 12, 2008 and have made amendments to the claims. It is submitted that the application, as amended, is in condition for allowance. By virtue of this amendment, claims 1-27 are pending. Claims 1, 18, 22, and 24 are amended. Reconsideration and allowance of the pending claims in view of the above amendments and the following remarks is respectfully requested.

In the Office Action, the Examiner:

- (1-2) rejected claims 24-27 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention;
- (3-5) rejected claims 1-8, 10-12, and 16 under 35 U.S.C. § 102(b) as being anticipated by K. Landsberger (U.S. Patent No. 3,749,369);
- (6-8) rejected claims 9, 13-14, and 17-23 under 35 U.S.C. § 103(a) as being unpatentable over K. Landsberger (U.S. Patent No. 3,749,369); and
- (9) indicated that claims 15 and 24-27 would be allowable if rewritten to overcome the rejections(s) under 35 U.S.C. § 112.

### (1-2) Rejection under 35 U.S.C. §112

The Examiner rejected claims 24-27 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

Applicants have amended claim 24 to more clearly and affirmatively recite that "the container [is] assembled by means of a method according claim 18," as suggested by the Examiner. No new matter was added. Claims 25-27 depend from amended claim 24. In view of the amendment to Claim 24, Applicants believe that the rejection of Claims 24-27, under 35 U.S.C. § 112, second paragraph, has been overcome. Applicants request that the Examiner withdraw the rejection of Claims 24-27.

(3-5) Rejection under 35 U.S.C. §102(b)

As noted above, the Examiner rejected claims 1-8, 10-12, and 16 under 35 U.S.C. § 102(b) as being anticipated by K. Landsberger (U.S. Patent No. 3,749,369).

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful. Amended independent claim 1 recites, *inter alia*:

the receiving portion is held in the container via the holding portion and may be positioned at **multiple locations within** the container by moving the holding portion. (emphasis added)

Support for the amendment can be found within, for instance, paragraph 0028 ("the holding device is so designed that the receiving portion 4 located in the container may be moved with the collecting vessel or the collecting vessels by turning or moving the holding portion 1 from the outside, in order to be able to cover a large proportion of the surface area of the base of the container"). No new matter has been added.

The present invention discloses a holding device for holding a receiving element in a container, the receiving element being provided for receiving a biological specimen. In accordance with the described invention, the receiving element is a cap-type receiving element, as shown in FIG. 4 of the instant application. In accordance with the described invention, the holding device may be used for performing a laser microdissection operation in the closed container with the biological material also being arranged in the closed container.

The holding device of the invention includes a holding portion (see reference numeral 1) arranged external to the container and a receiving portion (see reference numeral 4) for arrangement within the container and for holding the at least one receiving element (see reference numeral 9). See paras. 0028 and 0032, *inter alia*. The holding portion (1) and the receiving portion (4) are coupled to each other in contactless manner in such a way that (a) the receiving portion is held in the container via the holding portion, and (b) the receiving portion may be freely "positioned at multiple locations within" and relative to the container, as recited in newly amended claim 1.

Landsberger relates to a magnetic stirring apparatus having a support structure (14) that supports a liquid-mixing container (16). See Landsberger, col. 1, lines 1-16, col. 2, lines 22-46, claim 1, FIG. 1. A first rotatably-mounted magnetic bar (18) is arranged external to the container (16). *Id.* A second elongated bar magnet (20) encapsulated in a housing (22) is provided inside the container (16). *Id.* The housing (22) has a cavity (30) defining a measuring chamber (27) in its surface. *Id.* This measuring chamber (27) is provided for mixing additives with a liquid inside the container (16) (see column 1, lines 1-16 in combination with column 2, lines 22-46 as well as claim 1 and FIG. 1 of Landsberger). *Id.*

Contrary to the Examiner's analysis as outlined in the Office Action, the invention as defined by the presently pending independent claims clearly differs from the disclosure of Landsberger. In particular, the bar magnet (18) of Landsberger is only able to cause the mixing and measuring device (12) to "spin" about the axis A<sub>s</sub>. Landsberger, col. 3, lines 14-18. In other words, although it is able to spin, the mixing and measuring device (12) is in only a single location within the container (16). The magnetic bar (18) of Landsberger is entirely incapable of positioning a holding portion at multiple "locations" with the container.

Furthermore, Landsberger fails to show a "holding" portion. As noted above, in Landsberger, the housing (22) provided in the container (16) does have a cavity (30) for receiving additives which are to be mixed with a liquid contained in the container (16). Landsberger, col. 2, line 48 through col. 3, line 26. However, contrary to the wording of the presently pending independent claims, the cavity (30) or its measuring chamber (27) is not designed for "holding" any receiving element. In fact, Landsberger discloses exactly the opposite of "holding". The mixing and measuring device (12) of Landsberger is specifically designed so that the cavity (30) is turned "on its side" and that nothing is held by the cavity (30) so that all liquids are mixed together into a solution. *Id.*

Landsberger also fails to disclose a "*holding portion and [a] receiving portion* are

*coupled in contactless manner in such a way that the receiving portion is held in the container via the holding portion,"* as recited in amended claim 1 of the instant application. In Landsberger, the rotatably mounted magnetic bar (18), indeed, is magnetically coupled in contactless manner with the housing (22) arranged in the container (16), but this rotatably mounted magnetic bar (18) only and exclusively serves the purpose of rotating the housing (22) provided with a corresponding second elongated bar magnet (20) in the container (16) in accordance with its rotary motion. *Id.* Contrary to the wording of independent claim 1, the rotatably mounted magnetic bar (18) does not hold the housing (22) in the container (16).

In summary, in Landsberger, the housing (22) is provided with the elongated bar magnet (20), which can only be rotated by a corresponding rotary motion of the rotatably mounted magnetic bar (18) arranged externally of the container (16). In contrast thereto, however, the present invention provides a holding device which is able to "be positioned at multiple locations with the container by moving the holding portion." The magnetic arrangement proposed by Landsberger does not allow positioning at all and, particularly, does not disclose a "holding portion and [a] receiving portion [that] are coupled in contactless manner in such a way that the receiving portion is held in the container via the holding portion and may be positioned at multiple locations within the container by moving the holding portion".

The Examiner cites 35 U.S.C. § 102(b) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claims.<sup>1</sup> Because the elements in independent claim 1 of the instant application are not taught or disclosed by Landsberger, the apparatus of Landsberger does not anticipate the present invention. Dependent claims 2-8, 10-12, and 16 are believed to be patentable as well because they all are ultimately dependent claim 1. Accordingly, the present invention distinguishes over Landsberger for at least this reason. The

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<sup>1</sup> See MPEP §2131 (Emphasis Added) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim."

Applicants respectfully submit that the Examiner's rejection under 35 U.S.C. § 102(b) has been overcome.

(6-8) Rejection under 35 U.S.C. §103(a)

As noted above, the Examiner rejected claims 9, 13-14, and 17-23 under 35 U.S.C. § 103(a) as being unpatentable over K. Landsberger (U.S. Patent No. 3,749,369).

In the section entitled "(3-5) Rejection under 35 U.S.C. § 102(b)" above, the deficiencies of the prior-art system disclosed in the Landsberger reference were discussed. Claims 9, 13-14, and 17 depend directly from newly amended claim 1. Independent claim 1 distinguishes over Landsberger. Since dependent claims contain all the limitations of the independent claims, claims 9, 13-14, and 17 distinguish over Landsberger, as well.

Accordingly, the Applicants respectfully submit that it is not necessary at this stage to address the Landsberger reference as applied to claims 9, 13-14, and 17. Nor is it necessary to address whether or not there is sufficient suggestion or motivation with a reasonable expectation of success for modifying the Landsberger reference, as required by MPEP § 2143. As such, Applicants respectfully request that the Examiner's rejection of claims 9, 13-14, and 17 be withdrawn.

Amended independent claim 18 recites, *inter alia*:

positioning the receiving portion in the container by means of contactless coupling between the holding portion and the receiving portion by **moving the holding portion in a direction relative to the container.** (emphasis added)

Support for the amendment can be found within, for instance, paragraph 0028 ("the holding device is so designed that the receiving portion 4 located in the container may be moved with the collecting vessel or the collecting vessels by turning or moving the holding portion 1 from the outside, in order to be able to cover a large proportion of the surface area of the base of the container"). No new matter has been added.

The present invention discloses a holding device for holding a receiving element in a container, the receiving element being provided for receiving a biological specimen. In accordance with the described invention, the receiving element is a cap-type receiving element, as shown in FIG. 4 of the instant application. In accordance with the described invention, the holding device may be used for performing a laser microdissection operation in the closed container with the biological material also being arranged in the closed container.

The holding device of the invention includes a holding portion (see reference numeral 1) to be arranged externally of the container and a receiving portion (see reference numeral 4) for arrangement within the container and for holding the at least one receiving element (see reference numeral 9). See paras. 0028 and 0032, *inter alia*. The holding portion (1) and the receiving portion (4) are coupled to each other in contactless manner in such a way that (a) the receiving portion is held in the container via the holding portion, and (b) the receiving portion may be freely positioned, especially along the lower surface of the container, by "moving the holding portion in a direction relative to the container," as recited in newly amended claim 18.

Landsberger relates to a magnetic stirring apparatus having a support structure (14) that supports a liquid-mixing container (16). See Landsberger, col. 1, lines 1-16, col. 2, lines 22-46, claim 1, FIG. 1. A first rotatably-mounted magnetic bar (18) is arranged external to the container (16). *Id.* A second elongated bar magnet (20) encapsulated in a housing (22) is provided inside the container (16). *Id.* The housing (22) has a cavity (30) defining a measuring chamber (27) in its surface. *Id.* This measuring chamber (27) is provided for mixing additives with a liquid inside the container (16) (see column 1, lines 1-16 in combination with column 2, lines 22-46 as well as claim 1 and FIG. 1 of Landsberger). *Id.*

Contrary to the Examiner's analysis as outlined in the Office Action, the invention as defined by the presently pending independent claims clearly differs from the disclosure of Landsberger. In particular, the bar magnet (18) of Landsberger is only able to cause

the mixing and measuring device (12) to "spin" about the axis A<sub>5</sub>. Landsberger, col. 3, lines 14-18. In other words, although it is able to spin, the mixing and measuring device (12) is in only a single location within the container (16). The magnetic bar (18) of Landsberger is entirely incapable of "positioning the receiving portion in the container by ... by moving the holding portion in a direction relative to the container," as recited in amended claim 18 of the instant application.

Additionally, the bar magnet (18) is at a fixed distance from the support (14) and, as the known laws of magnetism dictate, the mixing and measuring device (12) is pulled to the bottom of the container (16) and remains a fixed distance from the bar magnet (18). For this reason as well, Landsberger fails to teach, show, or suggest "moving the holding portion in a direction relative to the container," as recited in newly amended claim 18 of the instant application.

Furthermore, Landsberger fails to teach, show, or suggest a "holding" portion. In Landsberger, the housing (22) provided in the container (16) does have a cavity (30) for receiving additives which are to be mixed with a liquid contained in the container 16. Landsberger, col. 2, line 48 through col. 3, line 26. However, contrary to the wording of the presently pending independent claims, the cavity (30) or its measuring chamber (27) is not designed for "holding" any receiving element. In fact, Landsberger discloses exactly the opposite of "holding". The mixing and measuring device (12) of Landsberger is specifically designed so that the cavity (30) is turned "on its side" and that nothing is held by the cavity (30) so that all liquids are mixed together into a solution. *Id.*

Landsberger also fails to teach, show, or suggest "wherein the receiving portion is held in the container by the holding portion," as recited in amended claim 18 of the instant application. In Landsberger, the rotatably mounted magnetic bar (18), indeed, is magnetically coupled in contactless manner with the housing (22) arranged in the container (16), but this rotatably mounted magnetic bar (18) only and exclusively serves the purpose of rotating the housing (22) provided with a corresponding second the elongated bar magnet (20) in the container (16) in accordance with its rotary motion. *Id.*

Contrary to the wording of the presently pending independent claims, the rotatably mounted magnetic bar (18) does not hold the housing (22) in the container (16).

When there is no suggestion or teaching in the prior art, the suggestion can not come from the Applicants' own specification. The Federal Circuit has repeatedly warned against using the Applicants' disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP § 2143 and *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and *In re Fitch*, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). It is accordingly believed to be clear that Landsberg neither shows nor suggests the features of claim 18. Claim 18 is, therefore, believed to be patentable over the art. Dependent claims 19-22 are believed to be patentable as well because they all are ultimately dependent on claim 18. The Examiner's rejection should be withdrawn

**(9) Allowable Subject Matter**

The Applicants wish to thank Examiner Kingan for indicating the allowable subject matter of claims 15 and 24-27. Because the Applicants respectfully disagree with the Examiner's rejection of independent claims 1 and 24, the Applicants have elected not to amend claims 15 and 24-27. The Applicants submit that, as argued above, claims 15 and 24-27 are already in a condition of allowance, which allowance is respectfully requested.

**CONCLUSION**

The remaining cited references have been reviewed and are not believed to affect the patentability of the claims as amended.

In this Response, Applicants have amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

Applicants acknowledge the continuing duty of candor and good faith to disclosure of information known to be material to the examination of this application. In accordance with 37 CFR §1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment are limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and their attorneys.

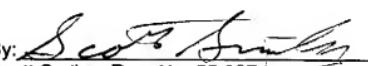
Applicants respectfully submit that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

It is believed that no fee is due with this Amendment. However, if any fees are due with respect to Sections 1.16 or 1.17, please charge to the deposit account of the undersigned firm, Acct. No. 503,836.

**PLEASE CALL** the undersigned if that would expedite the prosecution of this application.

Respectfully submitted,

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